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OFFICE OF PETITIONS

In re Application of
Roberts et al.
Application No. 09/929,031
Filed: August 15, 2001
Attorney Docket No. 41744

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.137(b)

This is in response to the "Petition under 37 CFR 1.181 to Consider Abandonment," filed November 12, 2002, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application .

The petition to revive the instant nonprovisional application under 37 CFR 1.137(b) is
GRANTED.

The petition includes a copy of the "Request to Rescind Previous Nonpublication Request," PTO/SB/36 (11-00), signed August 15, 2002 (received by the USPTO on August 15, 2002), and a "Request to Rescind Previous Nonpublication Request," PTO/SB/36 (10-01), signed November 12, 2002. Petitioner argues that the first-filed request to rescind should be treated as a notification of foreign filing. Petitioner argues that language added to the USPTO form for a Request to Rescind was already implicit in the previous version of the USPTO form, and that "the filing of a Request to Rescind is a tacit notice to the Director that the subject application is being filed internationally and/or in one or more foreign states." Furthermore, petitioner states that 35 U.S.C. § 122(b)(2)(B)(iii) does not specify a format in which the notice must be given, and that by filing of the rescission notice just prior to the anniversary of the filing date, applicant provided "de facto" notice that one or more foreign or international filings have occurred or would be occurring." Moreover, petitioner argues that filing an international application in the PCT Receiving Office can also be considered sufficient notice to the Director. Lastly, petitioner quotes from 35 U.S.C. § 122(b), and relies upon the phrase "regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional" to argue that Congress intended applications to only be considered abandoned where the delay is shown to have been intentional. In the alternative, petitioner requests that the petition be treated under 37 CFR 1.137(b).

35 U.S.C. § 122(b)(2)(B) states:

(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) An applicant may rescind a request made under clause (i) at any time.

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

37 CFR 1.213 implements the provisions of 35 U.S.C. § 122(b)(2)(B).

Most patent applications filed on or after November 29, 2000 will be published, unless applicant files a request for nonpublication in compliance with 37 CFR 1.213(a). A nonpublication request is required to contain a certification that "the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement that requires publication at eighteen months after filing." Applicants who do not plan to file in another country are not required to file such a certification, and given that provisional rights (see 35 U.S.C. § 154(d)) may be available to those who have their patent applications published, some applicants who do not plan to file in another country may elect to have their application published to be eligible for provisional rights. As a result, the filing of a rescission of a nonpublication request does not imply that the invention has been or will be filed in another country, and instead suggests that applicant now desires to have the application published in the United States.

Furthermore, 35 U.S.C. § 122(b)(2)(B)(ii) addresses rescission. If all rescissions provided notice of foreign filing, then 35 U.S.C. § 122(b)(2)(B)(iii), which requires applicants to provide notice of foreign filing within a set time period, would have provided that the "rescission specified in clause (ii) must be filed no later than 45 days after the date of foreign filing." Instead, clause (iii) merely specified that an "applicant who has made a request under clause (i)...shall notify the Director of such filing no later than 45 days after the date of such filing" and does not itself require such an applicant to rescind the nonpublication request. Implicit in providing notice of foreign filing is a rescission of the nonpublication request, but not *vice versa*. Thus the statute clearly identifies rescission of a nonpublication request and notification of a foreign filing as two separate acts, and a rescission in and of itself cannot be construed as notice of foreign filing.

As to the arguments that no specific notice is required and that filing an international application in the United States Receiving Office was a notification of foreign filing, these arguments are also not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b) provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject, so a notification of foreign filing was required to be on a separate paper from another matter (such as a new application), and so filing a copy of the international application in the above-identified

application would not have been notice of foreign filing.

On August 14, 2002, a Patent Cooperation Treaty application, Application No. PCT/US02/25698, was filed. A review of the contents of the file of the above-identified application shows that no notification of the filing of the PCT application was filed within 45 days after the filing date of the PCT application. As a result of petitioner's failure to provide timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), the above-identified application became abandoned midnight Monday September 30, 2002 (September 28, 2002 being a Saturday).

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the Office of a foreign filing must be accompanied by:

- (1) notification of such filing in a foreign country or under a multinational treaty;
- (2) the petition fee as set forth in 37 CFR 1.17(m); and
- (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

See 37 CFR 1.137(b) and (f).

The statement in the petition that "Applicant did not at any time intend to abandon the subject application" will be construed as meaning that "the entire delay in filing the required reply [the notification of the filing of the PCT application] until the filing of a grantable petition was unintentional." Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days as provided by 35 U.S.C. § 122(b)(2)(B)(iii) is accepted as having been unintentionally delayed.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. See 35 U.S.C. § 41(a)(7). Accordingly, as authorized, the required \$1,280 petition fee will be charged to Deposit Account No. 18-2220.

Any inquiries concerning this decision may be directed to Mark Polutta at (703) 308-8122.

This application is being forwarded to Technology Center Art Unit 2661 to await further examination in due course.



Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Corrected Filing Receipt